



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

SW

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,986	02/26/2004	Ofer Yodfat	MGP-002C3	2653
40888	7590	12/02/2004	EXAMINER	
MINDGUARD, LTD. C/O LANDON STARK CANTWELL & PAXTON c/o Langdon IP, In 1700 Diagonal Road Suite 450 Alexandria, VA 22314			LEWIS, AARON J	
			ART UNIT	PAPER NUMBER
			3743	

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/785,986

Applicant(s)

YODFAT ET AL.

Examiner

AARON J. LEWIS

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-6,11,12 are rejected under 35 U.S.C. 102(e) as anticipated by McKenzie et al. ('120).

As to claim 1, McKenzie et al. disclose an implantable device (10) for preventing the flow of embolic material flowing about a blood vessel bifurcation zone (e.g. figs.2 and 4) having a first branch vessel and a second branch vessel from entering the second branch vessel, the implantable device comprising: a deflecting portion (25) comprising a mesh having a mesh size sufficient to allow passage of blood to an inlet of the second branch vessel substantially without hindrance whilst occluding passage to said inlet of said second branch vessel of embolic material exceeding a predetermined size (col.9,

Art Unit: 3743

lines 30-35); and an anchoring portion (col.9, lines 11-13 and col.10, lines 19-21), associated with said deflecting element, said anchoring portion bearing against a vessel wall directly opposing said inlet of said second branch vessel to anchor said device therein.

As to claim 2, McKenzie et al. disclose said anchoring portion comprises an essentially cylindrically shaped body (col.8, lines 55-56).

As to claim 3, McKenzie et al. (figs.2 and 3) disclose said deflecting portion (25) is an annular section of said essentially cylindrically shaped body extending for the complete circumference of said anchoring portion.

As to claim 4, McKenzie et al. (figs.2 and 3) disclose said anchoring portion secures said deflecting element (25) across said inlet of said second branch vessel.

As to claim 5, McKenzie et al. (figs.2 and 3) disclose said anchoring portion is a stent adapted for insertion via the vasculature of an individual. That is, the device (20) of McKenzie et al. is in the form of stent.

As to claim 6, McKenzie et al. disclose said deflecting portion (25) is integrally formed with said anchoring portion (col.8, lines 55-56; col.9, lines 10-13; col.10, lines 18-21).

As to claim 11, the deflecting element (25) of McKenzie et al. is illustrated in figs.2 and 4 to span said inlet of said second branch vessel.

As to claim 12, McKenzie et al. (see abstract) disclose said first branch vessel is the External Carotid Artery (ECA), and said second branch vessel is the Internal Carotid Artery (ICA).

Art Unit: 3743

Claims 13-15 define a method of using the device defined by claims 1-6,11,12 and are anticipated by McKenzie et al. for the reasons set forth above with respect to claims 1-6,11,12.

Claims 19 and 20 are equivalent in scope to claims 11 and 12 and are anticipated by McKenzie et al. for the reasons set forth above with respect claims 11 and 12.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7,16 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKenzie et al. ('120) in view of Daniel et al. ('932).

The difference between McKenzie et al. and claim 7 is an express disclosure of the mesh of McKenzie et al. comprising an array of wires.

Daniel et al., in a vascular filter, teach an equivalency between a plurality of materials (including wires) from which a filtering portion (22) is made (col.3, lines 31-33).

It would have been obvious to make the filtering mesh of McKenzie et al. from any one of a plurality of materials including wires as mere substitution of one well known functionally equivalent material for another as taught by Daniel et al..

Claim 16 is substantially equivalent in scope to claim 7 and is included in McKenzie et al. as modified by Daniel et al..

5. Claims 8-10,17,18 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKenzie et al. ('120) in view of Daniel et al. ('932) and Barbut et al. ('555).

The differences between McKenzie et al. and claim 8 are the mesh being made of wires and the wires having a thickness between 10-200 microns.

Daniel et al., in a vascular filter, teach an equivalency between a plurality of materials (including wires) from which a filtering portion (22) is made (col.3, lines 31-33).

It would have been obvious to make the filtering mesh of McKenzie et al. from any one of a plurality of materials including wires as mere substitution of one well known functionally equivalent material for another as taught by Daniel et al..

Barbut et al. teach the variance of the physical parameters of a filtering mesh (40) in dependence upon the sizes of the particles that are intended to be trapped (col.9 line 9-col.11, line 44).

It would have been obvious to modify the physical parameters of the mesh of McKenzie et al. as modified by Daniel et al. including thickness of the wire of the mesh because of the necessity of constructing a filter based upon the sizes of the particles to be trapped as taught by Barbut et al..

As to claims 9 and 10, Barbut et al. as discussed above teach the adjustment of the mesh size and Reynolds number for the wires on the basis of the sizes of the particles intended to be trapped (col.9 line 9-col.11, line 44).

Claims 17 and 18 are substantially equivalent in scope to claim 8 and are included in McKenzie et al. as modified by Daniel et al. and Barbut et al. for the reasons set forth above with respect to claim 8.

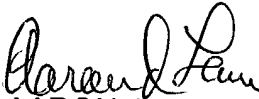
Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The balance of the art is cited to show relevant implantable devices for preventing the flow of embolic material.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON J. LEWIS whose telephone number is (571) 272-4795. The examiner can normally be reached on 9:30AM-6:00PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HENRY A. BENNETT can be reached on (571) 272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


AARON J. LEWIS
Primary Examiner
Art Unit 3743

Aaron J. Lewis

Application/Control Number: 10/785,986
Art Unit: 3743

Page 7

November 21, 2004